

REMARKS

Reconsideration and allowance in view of the following remarks are respectfully requested.
Claims 1-3 are pending.

Claims 1 and 3 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Wisdom et al. (US 4,122,198) in view of Hilton et al. (US 4,052,838), and Khalsa (US 5,298,274), and MacKendrick (US 3,520,248). The applicants respectfully traverse the rejection.

To establish a *prima facie* case of obviousness, (1) there must be some suggestion or motivation to modify a reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art reference(s) must teach or suggest all the claim limitations. MPEP §2143. The rejection of claims 1 and 3 as being unpatentable over Wisdom in view of Hilton and Khalsa and MacKendrick is improper because: (1) there is no suggestion or motivation cited in the Office Action for combining the teachings of these references; and (2) the references do not teach or suggest all the claim limitations.

Claim 1 is directed to a method of making a stackable triangular tortilla chip. The method includes the steps of "cutting triangular tortilla chip preforms...; enclosing the tortilla chip preforms in molds with a consistent orientation; restraining the tortilla chip preforms within said molds while cooking the tortilla chip preforms in a cooking medium...; and then removing cooked tortilla chips from said molds while substantially maintaining the orientation of the tortilla chip preforms; wherein said consistent orientation comprises an alternating pattern of tortilla chip preforms with base edges and apex corners of successive tortilla chip preforms within the molds alternating orientation...."

The cited references do not disclose the step of restraining triangular tortilla chip preforms in an alternating fashion within molds while cooking the preforms.

Wisdom describes that the preferred products are chip-type products which conform to the shape of a mold and are of a uniform size and shape so as to be capable of being stacked. (Col. 2, Ins. 52-55). There is no disclosure or suggestion of cutting chips in a triangular shape, orienting them in an alternating manner, and restraining them in the alternating orientations within a mold while being fried.

Hilton describes that uniformly-shaped chips can be physically restrained in a mold while being fried. (Col. 1, Ins. 24-26). There is no disclosure or suggestion of forming chips in a triangular shape, or orienting them in an alternating manner, and restraining them in a mold while oriented in the alternating manner.

Khalsa describes an apparatus for forming triangular tortilla chip preforms arranged in an alternating orientation. (Figure 2, col. 5, Ins. 32-47). Khalsa does not describe or suggest restraining the triangular, alternately - oriented chips in molds while being fried.

Finally, MacKendrick describes a method whereby oval-shaped chip preforms are cut and then restrained between saddle-shape mold elements during frying. (Figures 7, 8, col. 6, Ins. 13-47). There is no description or suggestion of forming triangular-shaped preforms and arranging them in an alternating manner and restraining the preforms within a mold while arranged in the alternating manner.

Accordingly, none of the cited references teaches or suggests the steps of "enclosing the [triangular] tortilla chip preforms in molds with a consistent orientation; restraining the tortilla chip preforms within said molds while cooking the tortilla chip preforms in a cooking medium, thereby substantially maintaining the orientation of the tortilla chip preforms while they are being cooked; ... wherein said consistent orientation comprises an alternating pattern of tortilla chip preforms with base edges and apex corners of successive tortilla chip preforms within the molds alternating orientation."

Furthermore, the Office Action fails to cite a plausible motivation for combining the references in the manner proposed. With respect to Hilton et al., it is suggested in the Office Action that it would have been obvious to modify Wisdom such that frying was completed in the mold since "[o]ne would have been substituting one known molding/frying step for another for the same purpose." Office Action at 2-3. If in fact the molding/frying steps described in Wisdom and Hilton serve the same purpose as asserted in the Office Action, what is the motivation for substituting one for the other? "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP §2143.01 at 2100-126. With respect to MacKendrick, it is suggested in the Office Action that because MacKendrick teaches uniformly shaped chip products formed using

molds that match the particular dough-cutting pattern, it would have been obvious to further modify Wisdom such that the mold section would align the cut pieces such that the base edges and the apex corners of successive tortilla chips are in alternating orientation since "(1) this was a known configuration for cutting triangular chips and (2) MacKendrick teaches the molds are aligned with the cutting pattern." Office Action at 3. Again, the proposed modification of Wisdom is no more than an assertion that the references can be combined, but no motivation for combining the references and modifying Wisdom as suggested is offered.

With respect to Khalsa it is suggested in the Office Action that it would be obvious to modify Wisdom to include a triangular-shaped chip "since one would have been substituting on [sic] tortilla chip form for another for the same purpose". Office Action at 3. Again, if the tortilla chips described in Wisdom and Khalsa serve the same purpose, what is the motivation for substituting one for the other? The alleged fact that the tortilla chips of Khalsa could be substituted for those of Wisdom does not, in and of itself, support an obviousness rejection based on those references. See MPEP §2143.01 at page 2100-126.

The Office Action fails to suggest a plausible motivation for combining the teachings of Wisdom, Hilton, Khalsa, and MacKendrick and merely alleges that the teachings of these references can be combined to derive the claimed invention. Without any motivation for actually combining the references and modifying the process described in Wisdom based on the teachings of the secondary references, the proposed combination/modification is no more than a hindsight reconstruction of the claimed invention. Thus, the Office Action fails to make out a *prima facie* case of obviousness. For these reasons, the rejection of claim 1 should be withdrawn.

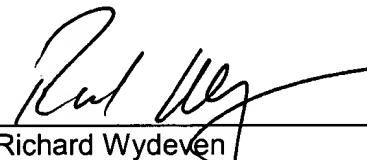
Claims 2 and 3 depend from claim 1 and are believed to be allowable as being dependent upon an allowable independent claim. Accordingly, the rejections of claims 2 and 3 should be withdrawn as well.

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All objections and rejections having been addressed, it is respectfully submitted that the present application is now in condition for allowance and a notice to that effect is earnestly requested.

Respectfully submitted,

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